

REMARKS

A. Election/Restriction Requirement

In the Office Action of September 12, 2002, it was asserted that Applicant's identification of claims 1-6 and 8-18¹ as covering the elected species was incorrect. Instead, the Office Action asserted that claims 1-5 and 7-18 covered the elected species. Applicant disagrees. In the Response to Restriction Requirement filed on August 21, 2002, Applicant elected the species shown in FIGS. 10 and 11. This was one of the species required for selection in the Election/Restriction Requirement mailed on June 21, 2002. The Election/Restriction Requirement then required the Applicant to identify the claims that cover the selected species. Claims 1-6 and 8-18 cover the species of FIGS. 10 and 11. As pointed out on page 5, lines 6-25, the species of FIGS. 10 and 11 contains cutouts/inserts and release paper heat transferred onto the top face. Thus, claim 6 covers the species of FIGS. 10 and 11. In addition, claim 7 does not cover the species of FIGS. 10 and 11 since no cutout with label insertion is formed on the top face. Accordingly, Applicant requests that claim 6 be examined in the next Office Action.

The Office Action has further stated that it was unclear how claims 1-6 and 8-18 are generic to both species. The Office Action then comments on claims 5-12. The Office Action has missed the point. Two species were identified in the Election/Restriction Requirement: 1) FIGS. 1 and 3 and 2) FIGS. 10 and 11. A claim is generic if it covers both species shown in FIGS. 1, 3 and 10, 11. Since claims 1-5² and 8-18 cover both the species shown in FIGS. 1, 3 and 10, 11, they are generic.

¹ Applicant's identification of claim 19 in his Response to Restriction Requirement filed on August 21, 2002 was an obvious error since the invention of claims 19-31 was not elected.

² Applicant's identification of claim 6 as being generic in his Response to Restriction

On a related matter, Applicant has canceled claims 19-31 and reserves the right to file them in a divisional application. Since the cancellation of claims 19-31 is in response to a Restriction Requirement, their cancellation is not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

B. 35 U.S.C. § 102(b)

Claims 1, 2, 13, 15-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fuller et al. Claim 1 has been canceled and so its rejection has been rendered moot. Regarding the remaining claims, claims 2, 13, 15 and 17 have been amended so as to depend directly on claim 7. Claim 7 recites a top face with a cutout into which an identification label is inserted. Fuller et al. does not recite forming a cutout in a top face of the base 10 and inserting an identification label within a cutout. Accordingly, claim 7 and its dependent claims 2, 13 and 15-18 are not anticipated by Fuller et al. Thus, the rejection should be withdrawn.

Besides not being anticipated by Fuller et al., the claims are not rendered obvious by Fuller et al. The Office Action has asserted that placing a color on subsection 14 constitutes indicia. Assuming for arguments sake that this is true, there is no suggestion in Fuller et al. to form a cutout in its top surface or a side wall and insert an identification label therein. Without suggestion to form a cutout in a top surface and insert an identification label therein, claim 7 and its dependent claims 2, 13 and 15-18 are patentable over Fuller et al.

Please note that claims 2, 13, 15 and 17 are being amended so as to change their dependency from canceled claim 1 to claim 7 in order to provide additional coverage for the

Requirement filed on August 21, 2002 was an obvious error.

invention of claim 7. Accordingly, the amendments made to claims 2, 13, 15 and 17 are not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

C. 35 U.S.C. § 103

1. Claims 7-12

Claims 7-12 were rejected under 35 U.S.C. § 103 as being obvious in view of Fuller et al. and Motooka et al. Claims 7-8 have been amended so as to be in independent form where claim 7 recites a top face with a cutout and claim 8 recites a side wall with a cutout into which an identification label is inserted. As pointed out above in Section B., Fuller et al. does not disclose or suggest forming a cutout in either a side wall or a top face of its base 10 and inserting an identification label therein. Motooka et al. does not cure the deficiencies of Fuller et al. While Motooka et al. discloses inserting a nameplate 10 in a glove, Motooka et al. is directed to nonanalogous art and so cannot be combined with Fuller et al.

The test for nonanalogous art is as follows:

The determination that a reference is from nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986) citing In re Wood, 559 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979).

Upon applying the first test, it is apparent that Motooka et al. is not within the Applicant's field of endeavor. Applicant's claimed invention is in the field of baseball or softball bases. In contrast, Motooka et al. is directed to baseball gloves.

Besides not being within the field of the inventor's endeavor it is clear that Motooka et al. is not reasonably pertinent to the particular problem with which the Applicant's were involved. As stated on page 1 of Applicant's specification, one of the problems attempted to be solved is that bases do not have the ability to be identified as a game or event specific item that would make it a collectible item.

Upon reviewing Motooka et al., it is apparent that Motooka et al. does not address Applicant's problems. In particular, Motooka et al. is directed to solving the problem that it is difficult to exchange a player's uniform number, playing position or name on baseball gloves (Col. 1, ll. 14-28). Since Motooka et al. is not reasonably pertinent to Applicant's particular problems, Motooka et al. fails the second test. Accordingly, it is respectfully submitted that a person having ordinary skill in the art of designing improved bases would not, without other suggestion, turn to the completely non-analogous devices of baseball gloves to find answers for improved bases. For this reason alone it is felt that the argued combination is inappropriate and that the rejection should be withdrawn.

Even if Motooka et al. is considered to be analogous art, the rejection is improper because there is no motivation to use Motooka et al.'s nameplate 10 on Fuller et al.'s base. In particular, Fuller et al. identifies the subsection 14 by coloring the subsection, including the side walls, with a distinctive color. There is no suggestion to use a nameplate as disclosed in Motooka et al. since such a nameplate would not be as distinctive to a base runner as the colored subsection disclosed in Fuller et al. since the nameplate would not cover as much area. Since there is no motivation to use a nameplate in Fuller et al.'s base, the rejection of claims 7-12 should be withdrawn.

Please note that claims 7 and 8 have been amended so as to incorporate subject matter that was inherently present in the original claims 7 and 8. Accordingly, the amendments made to

claims 7 and 8 are not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

2. Claim 14

Claim 14 was rejected under 35 U.S.C. § 103 as being obvious in view of Fuller et al. and Motooka et al. Applicant traverses this rejection for several reasons. First, claim 14 has been amended to be independent form and recites four side walls that define a square-like shape. As mentioned above in Section B, Fuller et al. does not disclose or suggest altering its base 10 so as to have a square-like shape. In contrast, Fuller et al. discloses a rectangularly shaped base 10 that includes subsections 12 and 14 (Col. 2, ll. 37-40). As shown in FIGS. 1 and 2, the subsection 12 is generally square-shaped and corresponds to a regular first base that is positioned in fair territory (Col. 2, ll. 43-46). The second subsection 14 has a like size and shape as subsection 12 and is located in foul territory (Col. 2, ll. 46-49). Since subsection 12 is square-like in shape and the two subsections are of like size and shape, it is impossible for Fuller et al.'s base 10 as shown to be square-like in shape. Accordingly, the base 10 shown in FIGS. 1 and 2 does not have a square-like shape as required by claim 14 and its dependent claims 1, 2 and 15-18.

It is noted that Fuller et al. does disclose that subsection 14 “may be of any desired size or shape” (Col. 2, ll. 51-52). However, this statement cannot be taken literally. The statement makes sense only if taken in the context that the size or shape is sufficient so that the subsection 14 can properly work for its intended purpose. As described in Fuller et al., the subsection 14 is designed for the batsman to step on when running from home to first base. The subsection 12 is

designed for the first baseman to tag with his or her foot. Thus, the subsection is designed to avoid having the runner and the first baseman from colliding or stepping on one another during a close play at first base (Col. 2, ll. 54-64). Obviously, if the subsection 14 was only 1/8" wide, it would not significantly avoid collisions since the small size would lead the base runner to frequently step on first base. In addition, the small size could lead to the twisting of ankles since the base runner would often step on the edge of subsection 14 in an attempt to avoid touching subsection 12. In addition, the small size could make it hard for the base runner to locate where subsection 14 is located. Based on the above observations, Fuller et al. clearly intended that the subsection 14 was of sufficient size as to be seen and that a foot could readily fit thereon without having the foot also being placed on subsection 12. With the intended size of subsection 14 in mind, it is clear that Fuller et al. does not disclose that the base 10 is square-like in shape. Indeed, Fuller et al. teaches away from having the base 10 being square-like in shape. In particular, Fuller et al. discloses that subsection 12 is square sized. The reason for this is so that the subsection 12 will be of legal size and shape when placed in fair territory. As explained above, Fuller et al. teaches away from having subsection 14 being of a small size such that the combination of subsections 12 and 14 could be considered to be square-like.

Motooka et al. does not cure the deficiencies of Fuller et al., since it also does not suggest altering the Fuller et al.'s base so as to have a square-like shape. Without such motivation, the rejection of claim 14 is improper and the rejection should be withdrawn.

The rejection is improper for the additional reason that Motooka et al. is directed to nonanalogous art as explained above in Section C.1.

Please note that claim 14 has been amended so as to incorporate subject matter that was

inherently present in the original claim 14. Accordingly, the amendment made to claim 14 is not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

3. Claims 3-5

Claims 3-5 were rejected under 35 U.S.C. § 103 as being obvious in view of Fuller et al. and Kennedy, III et al. Claims 3-5 depend directly on claim 2 and therefore depend indirectly on claim 7. Kennedy, III et al. does not suggest altering Fuller et al.'s base to have a cutout formed in the top surface and an identification label inserted therein. As described in Fuller et al., the preferred way of identifying the subsection 14 is to color the subsection, including the side walls, with a distinctive color. There is no suggestion to use a medallion as disclosed in Kennedy, III et al. since such a medallion would not be as distinctive to a base runner as the colored subsection disclosed in Fuller et al. since the medallion would not cover as much area. Since there is no motivation to use a medallion in Fuller et al.'s base, the rejection of claims 3-5 should be withdrawn.

The rejection should be withdrawn for the additional reason that Kennedy, III et al. is directed to nonanalogous art. In particular, Kennedy, III et al.'s field of endeavor is in the field of game balls (Col. 1, ll. 11-13) while Applicant's claimed invention is in the field of baseball or softball bases. Besides not being within the field of the inventor's endeavor, Kennedy, III et al. is not reasonably pertinent to Applicant's particular problem that bases do not have the ability to be identified as a game or event specific item that would make it a collectible item. Kennedy, III et al. is directed to the problem of placing a medallion on a gameball (Col. 1, ll. 16-47).

D. New Claim 32

New claim 32 depends from claim 7 and so is patentable over Fuller et al. and Motooka et al. for at least the same reasons given above in Section C.1. Claim 32 is patentable over Fuller et al. and Motooka et al. for the additional reason that it recites a base with side walls that define a square-like shape. As pointed out above in Section C.2, Fuller et al. and Motooka et al. do not suggest altering Fuller et al.'s subsection 14 to be square-like in shape.

Please note that new claim 32 is being present to provide additional coverage for a base. Accordingly claim 32 is not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

E. New Claims 33-41

New claims 33-41 depend directly or indirectly on claim 8 and so are patentable over Fuller et al. and Motooka et al. for at least the same reasons given above in Section C.1. Claim 34 is patentable over Fuller et al. and Motooka et al. for the additional reason that it recites a base with side walls that define a square-like shape. As pointed out above in Section C.2, Fuller et al. and Motooka et al. do not suggest altering Fuller et al.'s subsection 14 to be square-like in shape.

Please note that new claims 33-41 are being present to provide additional coverage for a base. Accordingly claims 33-41 are not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

F. New Claims 42-48

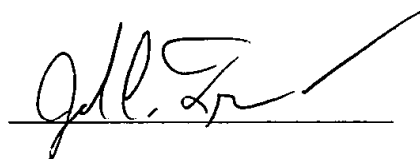
New claim 42-48 depend directly or indirectly on claim 14 and so are patentable over Fuller et al. and Motooka et al. for at least the same reasons given above in Section C.2.

Please note that new claims 42-48 are being present to provide additional coverage for a base. Accordingly claims 42-48 are not being presented for reasons of patentability as defined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000).

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 2-5, 7-12, 14-18 and 32-48 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J.C. Freeman', is written over a horizontal line.

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Marked Up Version of Amended Claims

2. (Amended) The base of claim [1] 7, wherein said identification label comprises indicia.

7. (Amended) A base for use during the play of baseball or softball, comprising:

a bottom;

a top face;

a side wall attached to said bottom and said top face,

an identification label attached to said top face; and

[The base of claim 1,] wherein said top face comprises a cutout into which said identification label is inserted.

8. (Amended) A base for use during the play of baseball or softball, comprising:

a bottom;

a top face;

a side wall attached to said bottom and said top face,

an identification label attached to said side wall; and

[The base of claim 1,] wherein said sidewall comprises a cutout into which said identification label is inserted.

13. (Amended) The base of claim [1] 7, further comprising:
a second sidewall attached to said sidewall, said bottom and said top face;
a third side wall attached to said second side wall, said bottom and said top face; and
a fourth sidewall attached to said sidewall, said third sidewall, said bottom and said top face.

14. (Amended) A base for use during the play of baseball or softball, comprising:
a bottom;
a top face;
a first side wall attached to said bottom and said top face,
a second sidewall attached to said first sidewall, said bottom and said top face;
a third side wall attached to said second side wall, said bottom and said top face;
a fourth sidewall attached to said first sidewall, said third sidewall, said bottom and said top face;
an identification label attached to either said top face or said first sidewall;
and

[The base of claim 13,] wherein said first side wall, said second side wall, said third side wall and said fourth side wall define a square-like shape.

15. (Amended) The base of claim [1] 7, further comprising a post attached to said bottom.

17. (Amended) The base of claim [1] 7, wherein said base is made of a resiliently deformable material.